Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL D. STROOM,
GARY F. HOWORTH and MICHAEL T. SCHWEITZER

Appeal No. 1997-1613
Application 08/109,646

HEARD: October 11, 2000

Before WARREN, OWENS and JEFFREY T. SMITH, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1, 2 4 through 9, 11 through 14, 17 through 20 and 23 through 32.[1]

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 over Merry in view of Wagner et al and either Luckanuck or Peterson et al.[2]

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[1] See the amendment of September 18, 1995 (Paper No. 26).

[2] The references are listed at page 3 of the answer.

The problem of protecting the edges of intumescent mounting mats of catalytic converters from erosion was recognized in the art as admitted by appellants, citing Merry as evidence of one solution to that problem (specification, page 1). Appellants claim another solution to the known problem wherein an edge protectant material as specified in , e.g., claim 1, is positioned between the metallic casing and the catalytic converted element. We find that the prior art applied to the claimed invention encompassed by the appealed claims by the examiner would not have reasonably suggested the claimed invention to one of ordinary skill in this art for two reasons. First, the examiner has not set forth in the record a scientific explanation why the teachings of the use of metal fabric for edge protection of intumescent mounting material in Merry (e.g., cols. 2-3) and the use of a compressible braided rope of fiberglass as sealing material at the edges of intumescent mounting material in Wagner et al. (e.g., cols. 8-9), either separately or combined would have reasonably suggested the use of an edge protectant material comprising a binder having disposed therein glass particles as specified in claim 1 for use in the reasonable expectation of reducing erosion of intumescent mounting material. We observe that the braided rope of fiberglass disclosed in Wagner et al. appears to be the same as or similar to other material acknowledged by appellants to have been applied to the edges of intumescent mounting mats (specification, page 1). Indeed, there is no evidence of record that ceramic containing materials other than those acknowledged by appellants (specification, page 1: "braided or rope-like ceramic (i.e., glass, crystalline ceramic, or glass-ceramic)") have been used in the art to protect the edges of intumescent mounting mats from erosion.

And, second, even assuming that one of ordinary skill in this art would have found in the teachings of Merry and Wagner et al. and in the art recognized use of other materials, including ceramic containing materials, acknowledged by appellants, the suggestion to employ other materials containing ceramic materials to protect the edges of intumescent mounting mats from erosion, we find no scientific explanation or evidence that this person would have been lead to combine these teachings with the teachings of Luckanuck and/or Peterson et al. in order to arrive at the claimed invention. There is no dispute that Luckanuck and Peterson et al. are not drawn to the same field of endeavor as the claimed invention, Merry and Wagner et al. Thus, the further issue with respect to whether Luckanuck and Peterson et al. are analogous prior art is whether either or both of them are reasonably pertinent to the

problem known in the catalytic converter art which appellants are attempting to solve. *See In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). We agree with appellants (brief, e.g., pages 13-15) that the examiner's contention that these references disclose materials "used to protect another material from high temperature situations" (answer, page 8) fails to establish that the reference are reasonably pertinent. *Id*. ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve."). We find that the fact that the claimed invention, Merry and Wagner et al. and both of Luckanuck and Peterson et al. are globally related with respect to protecting a material from high temperatures would not have provided one of ordinary skill in this art with the reasonable suggestion and expectation of success to use the materials taught in Luckanuck and/or Peterson et al. to solve the art recognized problem. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531(Fed. Cir. 1988) ("Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."); *Clay*, *supra*.

Thus, on this record, the examiner has not establishing a *prima facie* case of obviousness by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chemical*, 837 F.2d at 473, 5 USPQ2d at 1531-32; *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967).

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN Administrative Patent Judge	)	
TERRY J. OWENS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY T. SMITH Administrative Patent Judge	)	

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